

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES O. RICHARDSON

Appeal No. 96-2597
Application No. 08/187,529¹

HEARD: January 15, 1999

Before CALVERT, STAAB, and LALL, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 6, 12 and 24. The other claims remaining in the application, 7 to 11 and 13 to 18, have been indicated by the examiner as

¹ Application for patent filed January 27, 1994.

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allowable if rewritten to include all the limitations of the base claim.²

The appealed claims are reproduced in the appendix to appellant's brief. Claims 1, 6 and 12 are drawn to a fishing rod holder apparatus, and claim 24 to a method of holding a fishing rod.

The references applied in the final rejection are:

Barringer	2,709,544	May
31, 1955		
Albert	5,261,584	Nov. 16,
1993		

The claims on appeal stand finally rejected as follows:

- (1) Claims 1, 6 and 12, anticipated by Albert, under 35 U.S.C. § 102(b);
- (2) Claim 24, anticipated by Barringer, under 35 U.S.C. § 102(e).³

² In spite of his statement on page 4 of the final rejection that claims 7 to 11 and 13 to 18 "would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims," the examiner further stated on that page that the rejection under § 112, second paragraph, had been overcome, and did not further reject any claims on that ground.

³ The examiner notes in the answer that this rejection should have been under § 102(b) rather than § 102(e).

Rejection (1): Apparatus Claims

Albert discloses apparatus for supporting a pan 12 of the "mud" used when installing drywall boards. An upper clip 20 is hooked over the wearer's belt, and a lower brace 28 is strapped around the leg. Between them, they support a rectangular frame 14 made up of rods 16, 18 into which the pan 12 fits.

As argued by appellant, the issue with regard to this rejection is whether Albert discloses a "means for removably mounting the fishing rod upon said frame," as recited in claim 1. In order to anticipate a means-plus-function, a reference must disclose "structure which is capable of performing the functional limitation of the 'means'." RCA Corp. v. Applied Digital Data Systems Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984). The examiner asserts that "the 'means' (16) of Albert is functionally capable of holding a rod thereto if so desired" (answer, page 3), but does not explain how rods 16 of Albert have this capability. Presumably, the examiner considers that rods 16 would be capable of "removably mounting" a fishing rod

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if the rod were laid across them, or somehow wedged between them.

Even assuming *arguendo* that rods 16 of Albert would perform the function of "removably mounting" a fishing rod, appellant, citing In re Donaldson Co., Inc., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994), argues that the rods 16 of Albert do not anticipate because, when the claimed "means for removably mounting" is construed in the manner required by 35 U.S.C. § 112, sixth paragraph, rods 16 are not the equivalent of the structure described in appellant's specification which corresponds to that means. In considering this argument, we do not find in the specification any terminology, e.g., "mounting" or "removably mounting" the fishing rod, which specifically corresponds to the claimed function, nor does appellant identify in his brief what parts of his disclosed structure correspond to the "means for removably mounting the fishing rod upon said frame." Nevertheless, we consider that the structure described in the specification which corresponds to this means would be the tubular rod receiver 5, together with thumb screw 9, friction

member 11 and handle adapter 21, which removably secure the rod 22 in receiver 5 (page 10, lines 4 to 14).

One structure is the equivalent of another within the meaning of § 112, sixth paragraph, if it "results from an insubstantial change which adds nothing of significance to the [disclosed] structure." Valmont Industries, Inc. v. Reinke Mfg. Co., 983 F.2d 1039, 1043, 25 USPQ2d 1451, 1455 (Fed. Cir. 1993), quoted in Chiuminatta Concrete Concepts Inc. v. Cardinal Industries Inc., 145 F.3d 1303, 1309, 46 USPQ2d 1752, 1756 (Fed. Cir. 1998). Applying that test here, we believe it is evident that rods 16 of Albert would not simply be the result of an "insubstantial change" in appellant's disclosed tubular rod receiver and associated rod-securing parts.

The examiner, however, notes the following language at page 11, line 25, to page 12, line 7, of appellant's specification:

Although the invention has been described in detail with particular reference to these preferred embodiments, other embodiments can achieve the same results. Variations in the invention may include shape, size and arrangement of parts but variations and modifications of the present invention will be obvious to those skilled in the art and it is intended to cover in the appended claims all

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such modifications and equivalents. The entire disclosures of all references, patents, and publications cited above, are hereby incorporated by reference.

He then argues (answer, page 7) that this disclosure:

is an express teaching of very broad "equivalents" which has the effect of expanding the range of "means" which satisfy the claim language.

Secondly, and most importantly, appellant incorporates the "entire disclosure" of the patents cited on pp. 1 and 2 by reference (pg. 12, lines 5-7). This has the effect of introducing literally hundreds of variations of structure into the instant disclosure and claims. Not only do the four patents cited each teach a different "means for removably mounting" a fishing rod to another structure, each teaches a different "stabilizing" structure.

Following the instructions as per Donaldson and looking back to the specification for definition, the broadest reasonable interpretation of the "means for removably mounting" would seem to include just about any structure capable of holding a fishing rod. Since member (16) of Albert is thus capable for the reasons stated in the rejection, the claim limitation is satisfied.

With regard to the examiner's first point, we do not consider that an applicant's statement that the claims are intended to cover obvious variations and modifications of the invention opens up the recited means to cover all apparatus

capable of performing the claimed function. Such means must still be construed in accordance with the sixth paragraph of § 112, i.e., in relation to the corresponding structure described by appellant.

As for the four patents cited by appellant on pages 1 and 2 of the specification as exemplary of fishing rod holders in the prior art,⁴ it is not clear that appellant's incorporation of their "entire disclosures" by reference into his specification was intended as a disclosure that parts of the apparatus disclosed by these patents could be substituted for elements of appellant's described structure. Nevertheless, we have considered the rod-mounting means disclosed in each of these patents, and do not consider that the rods 16 of Albert would be the equivalent (§ 112, sixth paragraph) of the socket 40 with jaws 34, 36 of Pothetes, of the tubular supports 23 of Anderson or 1 of King, or of the holster 10 of Morse.

Accordingly, since Albert does not disclose the "means for removably mounting the fishing rod upon said frame"

⁴ Patent No. 4,739,914 (Pothetes); 4,802,612 (Anderson); 5,014,891 (King); and 5,123,573 (Morse). Copies of these patents were filed with an Information Disclosure Statement on January 27, 1994 (Paper No. 2).

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recited in claim 1, as construed in accordance with § 112, sixth paragraph, the rejection of claim 1, and of claims 6 and 12 dependent thereon, will not be sustained.

Rejection (2): Method Claim

Barringer discloses a fishing rod holder in which rod 74 is removably and rotatably mounted on frame 22. The frame is supported on the user by shoulder strap 44, and there is a keeper strap 60 across the open side of the frame (col. 2, lines 15 to 28). The examiner takes the position that Barringer anticipates claim 24 because strap 44 is an "upper stabilizer," strap 60 is a "lower stabilizer," and both straps are "removably attach[ed]
. . . to a person's body."

Considering first appellant's argument that, under In re Donaldson Co., Inc., *supra*, the examiner has not shown that Barringer's straps are the equivalent to appellant's disclosed stabilizers, we do not consider § 112, sixth paragraph, to be applicable here. Claim 24 is a method claim, and none of its steps are in a step-plus-function form. Cf. O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1583, 42 USPQ2d 1777, 1782 (Fed. Cir. 1997). Also, insofar as applicable, "stabilizer" is not

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a means-plus-function recitation, it being presumed from the absence of the term "means" that the sixth paragraph of § 112 does not apply, and appellant not having presented any basis for overcoming that presumption. See Personalized Media Communications, LLC v. ITC, 161 F.3d 696, 703, 48 USPQ2d 1880, 1887 (Fed. Cir. 1998).

It is fundamental that, during prosecution before the Patent and Trademark Office, a term in a claim is to be given its broadest reasonable interpretation, In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), unless appellant has clearly given it a special meaning in the specification.

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Multiform Desiccants Inc. v. Medzam Ltd., 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1433 (Fed. Cir. 1998). Appellant argues at page 6 of the brief that Barringer's straps 44 and 60 "offer no 'stabilizer' function or structure whatsoever insofar as that term is defined by Appellant." However, appellant does not identify, nor do we find, where in his disclosure the term "stabilizer" is defined; therefore, it must be given its broadest reasonable interpretation.

Appellant argues that Barringer's straps merely loosely encircle the user's body and, in his reply brief, asserts that they do not conform to dictionary definitions of "stabilize," i.e., "Barringer's device [does not] 'hold[] steady' or 'make[] stable' (especially against lateral motion)-- [it] merely provides a sort of dangling support" (reply brief, page 2). We do not agree. Strap 44 supports the frame at the user's waist (col. 2, lines 15 and 16) while strap 60, being a "keeper" (col. 2, lines 25 and 26) prevents the frame from swinging away from the user (to the user's right, in Fig. 1). Even though the straps may be "loose," as appellant argues, that does not preclude them from acting as stabilizers.

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Appellant further argues that Barringer's straps are not attached to the user's body, but merely encircle it (brief, page 6). This argument is not persuasive. "Attach" is defined in

Webster's Third New International Dictionary (1971) as "make fast or join," and straps 44 and 60 of Barringer are joined in a broad sense to the user's body, while still being removable therefrom, so that they are "removably attach[ed]," as recited. In view of appellant's argument concerning Barringer's straps "merely" encircling the body, we note that appellant's stabilizers 2, 3 are themselves attached to the user by straps 19, 20 which encircle the user's body.

Accordingly, the Barringer rod holder includes stabilizers as claimed, and since in normal usage of the Barringer apparatus one would inherently perform the steps recited in claim 24, claim 24 is anticipated by Barringer. In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). The rejection of claim 24 will be sustained.

Conclusion

The examiner's decision to reject claims 1, 6 and 12 is reversed, and to reject claim 24 is affirmed.

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No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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